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PATENT APPLICATION

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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Richard G. Sevier

Confirmation No.: 3095

Application No.: 10/700,215

Examiner: William C. Storey

Filing Date: 11/3/2003

Group Art Unit: 2625

Title: A digital image of a physical object

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PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on 6-21-2009.

☒ The fee for filing this Appeal Brief is \$540.00 (37 CFR 41.20).

☐ No Additional Fee Required.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

☐ (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d)) for the total number of months checked below:

☐ 1st Month
\$130

☐ 2nd Month
\$490

☐ 3rd Month
\$1110

☐ 4th Month
\$1730

☐ The extension fee has already been filed in this application.

☒ (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of \$ 540. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees.

Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First named Applicant: Richard G. Sevier	Group Art Unit: 2625
Application No.: 10/700,215 (CONF 3095)	
Filed: 11/3/2003	
Title: A digital image of a physical object	Examiner: William C. Storey
Attorney Docket No.: 200311063-1	

Assistant Commissioner for Patents
Washington, D.C. 20231

APPEAL BRIEF

This Appeal Brief is organized in accordance with the requirements set forth in 37 CFR 41.37(c).

Real party in interest

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holdings, LLC.

Related appeals and interferences

There are no related interferences to the present patent application, but one related appeal: Applicant previously appealed a prior final rejection of the instant patent application on August 13, 2008, and filed an appeal brief in support of the appeal on October 8, 2008. However, the Examiner reopened prosecution on January 2, 2009 via a new non-final office action with new grounds of rejection.

Status of claims

Claims 1, 5-10, 20, 24-29, and 39 are pending but stand rejected. Claims 2-4, 11-19, 21-23, 30-38, and 40-50 have been cancelled. The rejections of all pending claims are appealed.

Status of amendments

Applicant filed a response to the final office action of March 19, 2009, on May 17, 2009, in which claim 50 was cancelled and no other claims were amended or cancelled. The Examiner entered the cancellation of claim 50 in the advisory action of May 27, 2009. Therefore, there are no unentered claim amendments pending in the present patent application.

Summary of claimed subject matter

Claim 1

Claim 1 recites a digital image selection method that includes obtaining a first digital image of a first side of a physical object. See, e.g., Specification, paragraph [0039], page 9, lines 17-24. That physical object is a first of an ordered set of physical objects. See, e.g., Specification, paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). The first digital object is examined to determine if it is substantially blank. See, e.g., Specification, paragraph [0039], page 9, lines 17-24. If the first digital image is not substantially blank, a first set of digital images is obtained. See, e.g., Specification, paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). Each digital image of the first set is a digital image of a first side of a physical object of the ordered set of physical objects. See, e.g., Specification, paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). The first set of digital images is then sent for processing. See, e.g., Specification, paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number).

Only if the first digital image is substantially blank, a second digital image of a second side of the physical object is obtained. See, e.g., Specification, paragraphs [0040]-[0041.1] (paragraph 41.1 was added by amendment so it cannot be referenced by page and line number). Again, the physical object is the first of the ordered set of physical objects. See, e.g., Specification, paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). The second digital image is examined to determine if it is substantially blank. See, e.g., Specification, paragraphs [0040]-[0041.1] (paragraph 41.1 was added by amendment so it cannot be referenced by page and line number). If the first digital image is substantially blank and the second image is not substantially blank, a second set of digital images is obtained. See, e.g., Specification, paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). Each digital image of the second set is a digital image of a second side of a physical object of the ordered set of physical objects. See, e.g., Specification, paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). The second set is then sent for processing. See, e.g., Specification, paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number).

Claim 20

Claim 20 recites a computer readable medium having instructions for implementing a method that includes obtaining a first digital image of a first side of a physical object. See, e.g., Specification, paragraph [0039], page 9, lines 17-24. That physical object is a first of an ordered set of physical objects. See, e.g., Specification, paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). The first digital object is examined to determine if it is substantially blank. See, e.g., Specification, paragraph [0039], page 9, lines 17-24. If the first digital image is not substantially blank, a first set of digital images is obtained. See, e.g., Specification, paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). Each digital image of the first set is a digital image of a first side of a physical object of the ordered set of physical objects. See, e.g.,

Specification, paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). The first set of digital images is then sent for processing. See, e.g., Specification, paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number).

Only if the first digital image is substantially blank, a second digital image of a second side of the physical object is obtained. See, e.g., Specification, paragraphs [0040]-[0041.1] (paragraph 41.1 was added by amendment so it cannot be referenced by page and line number). Again, the physical object is the first of the ordered set of physical objects. See, e.g., Specification, paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). The second digital image is examined to determine if it is substantially blank. See, e.g., Specification, paragraphs [0040]-[0041.1] (paragraph 41.1 was added by amendment so it cannot be referenced by page and line number). If the first digital image is substantially blank and the second image is not substantially blank, a second set of digital images is obtained. See, e.g., Specification, paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). Each digital image of the second set is a digital image of a second side of a physical object of the ordered set of physical objects. See, e.g., Specification, paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). The second set is then sent for processing. See, e.g., Specification, paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number).

Claim 39

Claim 39 recites a system for digital image selection. The system includes an image manager and a content module. See, e.g., Specification, paragraph [0024], page 5, lines 18-32 and Fig. 3. The image manager is operable to obtain a first digital image of a first side of a physical object and a second digital image of a second side of the physical object. See, e.g., Specification, paragraph [0027], page 6, lines 15-24. The content module is operable to examine the first digital image to determine if it is substantially blank. See, e.g., Specification, paragraph [0024]-[0025],

page 5, line 18 through page 6, line 10. The image manager is further operable to send the second digital image for processing if the first digital image is substantially blank and to send the first digital image for processing if the first digital image is not substantially blank. See, e.g., Specification, paragraph [0027]-[0028], page 6, line 15 through page 7, line 2. The physical object is a first of an ordered set of physical objects. See, e.g., Specification, paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). The image manager is further operable to, if the first digital image is determined to not be substantially blank, obtain a first set of digital images. See, e.g., Specification, paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). Each digital image of the first set being a digital image of a first side of a physical object of the ordered set of physical objects. See, e.g., Specification, paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). The image manager then sends the first set of digital images for processing.

The image manager is further operable to, only if the first digital image is substantially blank as determined by the content module, obtain a second digital image of a second side of the physical object, the physical object being the first of the ordered set of physical objects. See, e.g., Specification, paragraphs [0040]-[0041.1] (paragraph 41.1 was added by amendment so it cannot be referenced by page and line number). The image manager is further operable to, if the first digital image is determined to be substantially blank and the second image is not substantially blank as determined by the content module, obtain a second set of digital images. See, e.g., Specification, paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). Each digital image of the second set being a digital image of a second side of a physical object of the ordered set of physical objects. See, e.g., Specification, paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number). The image manager then sends the second set of digital images for processing. See, e.g., Specification, paragraph [0041.1] (this paragraph was added by amendment so it cannot be referenced by page and line number).

Grounds of rejection to be reviewed on appeal

- A. Claims 1, 5-8, 20, 24-27, 39, and 50 stand rejected under 35 U.S.C. 103 as being unpatentable over USPN 6,169,873 issued to Connolly.
- B. Claims 9 and 28 stand rejected under 35 USC §103 as being unpatentable over Connolly in view of US Pub 2003/0048470 to Garcia.
- C. Claims 10 and 29 stand rejected under 35 USC §103 as being unpatentable over Connolly in view of Okubo and in further view of well known prior art.

Argument

Grounds for Rejection A

Claims 1, 5-8, 20, 24-27, 39, and 50 stand rejected under 35 U.S.C. 103 as being unpatentable over USPN 6,169,873 issued to Connolly. Claim 1 is directed to a digital image selection method and recites the following:

1. obtaining a first digital image of a first side of a physical object, the physical object being a first of an ordered set of physical objects;
2. examining the first digital image to determine if it is substantially blank;
3. if the first digital image is not substantially blank, obtaining a first set of digital images, each digital image of the first set being a digital image of a first side of a physical object of the ordered set of physical objects, and sending the first set of digital images for processing;
4. only if the first digital image is substantially blank, obtaining a second digital image of a second side of the physical object, the physical object being the first of the ordered set of physical objects and examining the second digital image to determine if it is substantially blank; and
5. if the first digital image is substantially blank and the second image is not substantially blank, obtaining a second set of digital images, each digital image of the second set

being a digital image of a second side of a physical object of the ordered set of physical objects, and sending the second set of digital images for processing.

To summarize, a digital image of the first side of an initial page of a set of pages is obtained. It is determined if that digital image is blank. Only if blank, a second digital image of the second side of the initial sheet is obtained. Then, if the first digital image is determined to be blank and the second digital image is not, the second sides of set of pages are obtained and sent for processing. If the first digital image is not blank, digital images of the first sides of set of pages are obtained and sent for processing. Only if the first digital image is blank, is the second digital image. If the second digital image is not blank, digital images of the second sides of set of pages are obtained and sent for processing.

At page 3 of the September 18, 2008 office action, the Examiner admits that Connolly does not "disclose checking only one image for face orientation, and then making the assumption for the rest of the sheets in the stack." Instead, the Examiner contends that it would be obvious to modify Connolly to provide checking only one image for face orientation, and then making the assumption for the rest of the sheets in the stack for the purpose of increasing speed. The Appellant respectfully disagrees.

Connolly, at column 6, lines 31-33 scans both sides of a sheet in steps 33-35 before making a determination as to whether either side is blank in steps 41 and 43. This is required to achieve Connolly's express purpose of determining whether or not sheets placed in a sheet feeder have a simplex or a duplex image presentation. See, e.g., Connolly, Abstract. Further, Connolly expressly states:

Referring to FIG. 2, a document provided to the sheet feeder 13 (FIG. 1) is scanned in order to determine, among other **required** functions, if images appear on one or both sides of the first pages.

Connolly, col. 6, lines 28-31 (emphasis added). In other words, Connolly expressly labels the function of determining whether or not a document placed on a sheet feeder is double sided as **required**.

The US Supreme Court has recently stated:

[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

KSR Intl Co. v. Teleflex, Inc, 550 U.S. _____, 127 S. Ct. 1727 (April 30, 2007) (pages 15-16 of the Bench Opinion). This is consistent with MPEP § 2143.01(V) which provides:

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.

MPEP §2143.01(V), citing In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

At a minimum, the Examiner must, in light of KSR, establish that a person of ordinary skill in the art would have reasonably modified Connolly in the manner suggest. The Appellant respectfully maintains that such a showing cannot be made. Connolly requires that both sides of at least the first sheet of a document be scanned to determine whether or not the document is double sided. Modifying Connolly to scan the second side only if the first side is not blank is not an option. The modification would render Connolly unsuitable for its intended purpose. Thus one of ordinary skill in the art would not be inclined to modify Connolly in the manner suggested by the Examiner. For at least this reason, Claim 1 and Claims 5-8 are patentable over Connolly.

Claim 20 is directed to a computer readable medium having instructions for implementing the method of Claim 1. For at least the same reasons Claim 1 is patentable, so are Claim 20 and Claims 23-29 which depend from Claim 20.

Claim 39 is directed to a system having various components configured to implement the method of Claim 1. For at least the same reasons Claim 1 is patentable, so is Claim 39.

Grounds for Rejection B

Claims 9 and 28 were rejected as being unpatentable over Connolly in view of US Pub 2003/0048470 to Garcia. Claims 9 and 28 each depend from an allowable base claim and is allowable based at least on that dependency.

Grounds for Rejection C

Claims 10 and 29 were rejected as being unpatentable over Connolly in view of Okubo and in further view of well known prior art. Claims 10 and 29 each depend from an allowable base claim and is allowable based at least on that dependency.

Respectfully Submitted,



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Claims appendix

1. (previously presented) A digital image selection method, comprising:
 - causing a scan engine to initiate a scan of an ordered set of physical objects;
 - obtaining a first digital image of a first side of a physical object, the physical object being a first of the ordered set of physical objects scanned by the scan engine;
 - examining the first digital image to determine if it is substantially blank;
 - if the first digital image is not substantially blank, obtaining a first set of digital images, each digital image of the first set being a digital image of a first side of a physical object of the ordered set of physical objects scanned by the scan engine, and sending the first set of digital images for processing by one of a print engine, a facsimile engine, an e-mail engine, and a file manager;
 - only if the first digital image is substantially blank, obtaining a second digital image of a second side of the physical object, the physical object being the first of the ordered set of physical objects scanned by the scan engine and examining the second digital image to determine if it is substantially blank;
 - if the first digital image is substantially blank and the second image is not substantially blank, obtaining a second set of digital images, each digital image of the second set being a digital image of a second side of a physical object of the ordered set of physical objects scanned by the scan engine, and sending the second set of digital images for processing by one of the print engine, the facsimile engine, the e-mail engine, and the file manager.
- 2.-4. (cancelled)
5. (original) The method of Claim 1, further comprising discarding the first digital image if it is substantially blank.

6. (previously presented) The method of Claim 1, wherein the steps of obtaining the first and second sets of digital images comprise:

causing the scan engine to scan the first side of each physical object in the ordered set to generate the first set of digital images; and

causing the scan engine to scan the second side of each physical object in the ordered set to generate the second set of digital images.

7. (previously presented) The method of Claim 1, wherein:

sending the second set of digital images for processing comprises sending the second set of digital images to be printed if the first digital image is substantially blank; and

sending the first set of digital images for processing comprises sending the first set of digital images to be printed if the first digital image is not substantially blank.

8. (previously presented) The method of Claim 1, wherein:

sending the second set of digital images for processing comprises sending the second set of digital images to be incorporated in a facsimile transmission if the first digital image is substantially blank; and

sending the first set of digital images for processing comprises sending the first set of digital images to be incorporated in a facsimile transmission if the first digital image is not substantially blank.

9. (previously presented) The method of Claim 1, wherein:

sending the second set of digital images for processing comprises sending the second set of digital images to be incorporated in an electronic mail message if the first digital image is substantially blank; and

sending the first set of digital images for processing comprises sending the first set of digital images to be incorporated in an electronic mail message if the first digital image is not substantially blank.

10. (previously presented) The method of Claim 1, wherein:
 sending the set of digital images image for processing comprises sending the second set of digital images to be archived if the first digital image is substantially blank; and
 sending the first set of digital images for processing comprises sending the first set of digital images to be archived if the first digital image is not substantially blank.

11.-19. (cancelled)

20. (previously presented) A computer readable medium having instructions for:
 causing a scan engine to initiate a scan of an ordered set of physical objects;
 obtaining a first digital image of a first side of a physical object, the physical object being a first of the ordered set of physical objects, scanned by the scan engine;
 examining the first digital image to determine if it is substantially blank;
 if the first digital image is not substantially blank, obtaining a first set of digital images, each digital image of the first set being a digital image of a first side of a physical object of the ordered set of physical objects scanned by the scan engine, and sending the first set of digital images for processing by one of a print engine, a facsimile engine, an e-mail engine, and a file manager;
 only if the first digital image is substantially blank, obtaining a second digital image of a second side of the physical object, the physical object being the first of the ordered set of physical objects scanned by the scan engine and examining the second digital image to determine if it is substantially blank; and
 if the first digital image is substantially blank and the second image is not substantially blank, obtaining a second set of digital images, each digital image of the second set being a digital image of a second side of a physical object of the ordered set of physical objects scanned by the scan engine, and sending the second set of digital images for processing by one of the print engine, the facsimile engine, the e-mail engine, and the file manager.

21.-23. (cancelled)

24. (original) The medium of Claim 20, having further instructions for discarding the first digital image if it is substantially blank.

25. (previously presented) The medium of Claim 20, wherein the instructions for obtaining the first and second sets of digital images include instructions for:

causing the scan engine to scan the first side of each physical object in the ordered set to generate the first set of digital images; and

causing the scan engine to scan the second side of each physical object in the ordered set to generate the second set of digital images.

26. (previously presented) The medium of Claim 20, wherein the instructions for:

sending the second set of digital images for processing include instructions for sending the second set of digital images to be printed if the first digital image is substantially blank; and

sending the first set of digital images for processing include instructions for sending the first set of digital images to be printed if the first digital image is not substantially blank.

27. (previously presented) The medium of Claim 20, wherein the instructions for:

sending the second set of digital images for processing include instructions for sending the second set of digital images to be incorporated in a facsimile transmission if the first digital image is substantially blank; and

sending the first set of digital images for processing include instructions for sending the first set of digital images to be incorporated in a facsimile transmission if the first digital image is not substantially blank.

28. (previously presented) The medium of Claim 20, wherein the instructions for:

sending the second set of digital images for processing include instructions for sending the second set of digital images to be incorporated in an electronic mail message if the first digital image is substantially blank; and

sending the first set of digital images for processing include instructions for sending the first set of digital images to be incorporated in an electronic mail message if the first digital image is not substantially blank.

29. (previously presented) The medium of Claim 20, wherein the instructions for sending the second set of digital images for processing include instructions for:

sending the second set of digital images to be archived if the first digital image is substantially blank; and

sending the first set of digital images for processing include instructions for sending the first set of digital images to be archived if the first digital image is not substantially blank.

30.-38. (cancelled)

39. (previously presented) A system for digital image selection, comprising a computer readable medium having instructions that when executed function as an image manager and a content module:

the image manager is operable to obtain a first digital image of a first side of a physical object and a second digital image of a second side of the physical object;

the content module is operable to examine the first digital image to determine if it is substantially blank and to examine the second digital image to determine if it is substantially blank; and

wherein the image manager is further operable to send the second digital image for processing if the first digital image is substantially blank and to send the first digital image for processing if the first digital image is not substantially blank;

wherein the physical object is a first of an ordered set of physical objects and wherein the image manager is further operable to:

if the first digital image is determined to not be substantially blank by the content module, obtain a first set of digital images, each digital image of the first set being a digital image of a first side of a physical object of the ordered set of physical objects, and send the first set of digital images for processing;

only if the first digital image is substantially blank as determined by the content module, obtain a second digital image of a second side of the physical object, the physical object being the first of the ordered set of physical objects;

if the first digital image is substantially blank and the second image is not substantially blank as determined by the content module, obtain a second set of digital images, each digital image of the second set being a digital image of a second side of a physical object of the ordered set of physical objects, and send the second set of digital images for processing.

40.-50.(cancelled)

Evidence Appendix

(No evidence was submitted pursuant to Rules 130, 131, and 132, and therefore, this section is blank.)

Related Proceedings Appendix

(There are no related proceedings to this patent application, and therefore, this section is blank.)